

**F A X C O V E R**

Date Tuesday, April 10, 2007 **Number of pages (including cover):** 6

To Examiner Ly

Company USPTO

Your File # 10/624,304

Tel 571-272-4039

Fax 571-273-4039

From David Gesner for Randy Pritzker

Direct dial 617-646-8341

Our File # S1459.70053U500

ORIGINAL DOCUMENTS SENT: ☐ 1st Class Mail ☐ Overnight Mail ☐ Air Mail ☐ Not Sent

MESSAGE:

Applicant's representatives would like to discuss the attached in a telephone interview.

This transmission contains confidential information intended for use only by the above-named recipient. Reading, discussing, distributing, or copying this message by anyone other than the named recipient, or his or her employees or agents, is strictly prohibited. If you have received this fax in error, please notify us immediately by telephone (collect), and return the original message to us at the address below via the U.S. Postal Service.

IF YOU DID NOT RECEIVE ALL OF THE PAGES OF THIS TRANSMISSION OR IF ANY OF THE PAGES ARE ILLEGIBLE, PLEASE CALL 617.646.8000 IMMEDIATELY.

Wolf Greenfield Fax Number: 617.646.8646

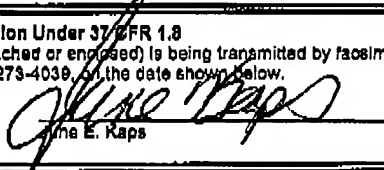
Wolf, Greenfield & Sacks, P.C. | 600 Atlantic Avenue | Boston, Massachusetts 02210-2206
617.646.8000 | fax 617.646.8646 | www.wolfgreenfield.com

PATENTS TRADEMARKS COPYRIGHTS TECHNOLOGY TRANSFERS LITIGATION

Docket No.: S1459.70053US00
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Masafumi Matsuda et al.
Serial No.: 10/624,304
Confirmation No.: 7805
Filed: July 22, 2003
For: DATA PROCESSING APPARATUS, DATA PROCESSING
METHOD, DATA PROCESSING SYSTEM, STORAGE MEDIUM
AND PROGRAM
Examiner: A. Ly
Art Unit: 2162

Certificate of Transmission Under 37 CFR 1.8	
I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted by facsimile to Examiner A. Ly, Group Art Unit 2162, U.S. Patent and Trademark Office, facsimile no. (571) 273-4039, on the date shown below.	
Dated: 4/10/07	
John E. Kaps	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

INTERVIEW AGENDA – NOT FOR ENTRY

In response to Examiner Ly's request, a proposed agenda for a telephone interview follows. Examiner Ly has requested a proposed agenda before agreeing to grant the telephone interview.

Applicants' representatives request the interview to discuss claim rejections under 35 U.S.C. §101, §112 and §103, as follows:

I. Rejections under 35 U.S.C. §101

A. Claims Rejected For Purportedly Failing To Satisfy The Utility Requirement

Claims 1-6, 8-10 and 18-39 are rejected under 35 U.S.C. §101 for purportedly "lacking of real world useful result." Specifically, the Office Action contends that these claims "are missing the steps or processes producing any useful result to the invention."

1172108.1

Application No.: 10/624,304
NOT FOR ENTRY

2

Docket No.: S1459.70053US00

Claims 1-6, 8-10 and 18-39 are believed to satisfy the utility requirement. M.P.E.P. §2107(ID)(B)(1) provides that "[i]f the applicant has asserted that the claimed invention is useful for any particular practical purpose (i.e., that it has a "specific and substantial utility") and the assertion would be considered credible by a person of ordinary skill in the art, do not impose a rejection based on lack of utility." A specific utility is one that "is specific to the subject matter claimed and can "provide a well-defined and particular benefit to the public." M.P.E.P. §2107(.01)(I)(A). "[T]o satisfy the 'substantial' utility requirement, an Applicant must show that the claimed invention has a significant and presently available benefit to the public." M.P.E.P. §2107(.01)(D)(B).

It is believed that the invention recited by each of claims 1-6, 8-10 and 18-39 has a specific and substantial utility. For example, claim 1 produces a result of transmitting a list showing a content data item which is selected from a plurality of content data items depending on its reproduction status. This result provides a benefit to the public which is both well-defined and particular (and thus "specific") and significant and presently available (and thus "substantial").

Accordingly, Applicant's representatives wish to discuss why the Examiner believes claims 1-6, 8-10 and 18-39 are "lacking of real world useful result."

B. Claims Rejected For Purportedly Reciting Non-Statutory Subject Matter

Claims 10 and 31-39 are rejected for purportedly reciting non-statutory software *per se*. Claim 10 recites at least one computer-readable medium having instructions encoded thereon which, when executed, perform a process comprising a plurality of steps including transmitting a list.

The Office Action contends that because one step in the process is to transmit a list, the computer readable medium recited by claim 10 comprises a transmission signal, which the Office Action alleges is non-statutory subject matter. The Office Action also contends that the list that is transmitted comprises descriptive material, which itself is non-statutory subject matter.

Without acceding to the propriety of the rejection, Applicant's representatives propose to amend claim 10 to recite an article of manufacture comprising at least one computer-readable

Application No.: 10/624,304
NOT FOR ENTRY

3

Docket No.: S1459.70053US00

medium having instructions encoded thereon, and wish to discuss with the Examiner whether this proposed amendment would overcome the rejection of claim 10 and 31-39 under §101.

II. Rejections under 35 U.S.C. §112

Claim 18 is rejected under 35 U.S.C. §112, first paragraph, for purportedly failing to comply with the written description requirement. Specifically, the Office Action contends that limitations requiring a "first reproducing unit" and "second reproducing unit" lack support in the specification or drawings.

Applicant's representatives wish to discuss the basis for this rejection with the Examiner, as it is believed that these limitations find support in the specification and drawings. For example, FIG. 1 depicts portable terminals 11-1 through 11-6 (see, e.g., Applicant's specification at p. 12, lines 10-12). Functions implemented by each of portable terminals 11-1 through 11-6 are shown in the functional block diagram of Fig. 3 (p. 15, lines 10-12). For example, each portable terminal includes a "reproduction unit" that reproduces tunes stored in a storage unit (p. 16, lines 1-3). Because each portable terminal includes a reproduction unit, each portable terminal may be considered a "reproducing unit," as recited by claim 18. Fig. 1 depicts multiple reproducing units (i.e., portable terminals 11-1 through 11-6), such that one of the reproducing units may be considered a "first reproducing unit" and another may be considered a "second reproducing unit."

Accordingly, Applicant's representatives wish to discuss why the Examiner believes the limitations of claim 18 lack support in the specification or drawings.

III. Rejections under 35 U.S.C. §103

1-10 and 18-39 are rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over U.S. Patent Publication No. 2001/0006771 to Kajiyama et al. ("Kajiyama") in view of U.S. Patent Publication No. 2002/0131594 to Hori et al. ("Hori"). Without acceding to the propriety of the

Application No.: 10/624,304
NOT FOR ENTRY

4

Docket No.: S1459.70053US00

asserted combination, Applicant's representatives wish to propose amendments to each of claims 1-10 and 18-38 which patentably distinguish over the prior art of record. A marked-up version of claim 1 is provided below to illustrate proposed amendments to each independent claim:

1. A data processing apparatus comprising:
 - a reproducing unit configured to reproduce a plurality of content data items;
 - a control unit configured to detect a reproduction status of each content data item being when said each content data item is reproduced by said reproducing unit, and to select a recommendation content data item from said plurality of content data items depending on a reproduction status of said recommendation content data item; and
 - a communication unit configured to transmit to another data processing apparatus a list which shows said selected recommendation content data item.

Neither Kajiyama nor Hori discloses or suggests the limitations recited by amended claim 1. For example, Kajiyama, which the Office Action cites as purportedly meeting all of the limitations of claim 1 except for a communication unit configured to transmit to another data processing apparatus, fails to disclose or suggest detecting a reproduction status of a plurality of content data items *when each contend data item is reproduced*. Rather, Kajiyama discloses a method which employs pre-recorded reproduction management information. Kajiyama also does not disclose or suggest selecting a *recommendation content data item* depending on a reproduction status. Kajiyama does not disclose a recommendation content data item which is selected depending on its reproduction status.

Applicant's representatives wish to discuss these proposed amendments in light of the prior art of record, and to discuss whether the Examiner would be amenable to entering the amendments under 37 C.F.R. §1.116.

Application No.: 10/624,304
NOT FOR ENTRY

5

Docket No.: S1459.70053US00

Applicants' representatives thank Examiner Ly for agreeing to review this proposed agenda. If the Examiner has any questions concerning the foregoing, he is invited to contact the undersigned at the number provided below.

Dated: 4-10-07

Respectfully submitted,

By Randy J. Pritzker
Randy J. Pritzker
Registration No.: 35,986
WOLF, GREENFIELD & SACKS, P.C.
Federal Reserve Plaza
600 Atlantic Avenue
Boston, Massachusetts 02210-2206
(617) 646-8000